In The United States Patent And Trademark Office

#22 Appeal Brief

Appl. Number:	09/978,215
Appl. Filed:	10/15/01
Applicant:	Luis J. Rodriguez
Title:	Self Sealing Letter Sheets *(Formerly "Self Sealing Forms")*
Examiner / GAU:	Stephen P. Garbe / 3727

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

In accordance with notice of Appeal filed January 09, 2003, applicant respectfully submits the present Appeal Brief:

(1) Real party in interest

The real party in interest is the Applicant listed above.

(2) Related appeals and interferences

None

(3) Status of claims

Claims 01-70 have been rejected.

Claims 01-44 have been canceled.

Claims 45-70 are pending.

Claims 45-59 and 61-70 are appealed

(4) Status of Amendments

- Advisory Action of 10/25/02 denied entry of Amendment C.
- Advisory Action of 10/25/02 further denied entry of Amendment C for purposes of appeal.
- A petition to the Commissioner, to enter Amendment C was filed on January 09, 2003.
- A response to the Petition to the Commissioner is pending.
- Portions of Amendment C served as a demonstration exhibit during interview of October 29, 2002, and are therefore entered in the record. These portions are: page 39, and the discussion of rejection of claims 68-70 on last two paragraphs of page 36, and paragraphs 1-5 of page 37. See Summary of Interview by applicant, page 3, sections 4) and 5).

(5) Summary of the invention

The invention is a self sealing letter sheet made of a blank of a sheet material. A typical embodiment of the invention resembles a conventional letter sheet, —just like the 8½" x 11" sheets in a ream purchased at Staples™ or any stationery store— folded so it has at least one rectangular body —the letter sheet itself— and at least one marginal flap. The self sealing letter sheet further has:

-at least one area having a layer of a fastener substance (e.g. pressure sensitive adhesive, a.k.a. PSA),

-at least one area having a layer of a fastener inhibitor substance (e.g. Silicone),

-at least one blank area (free of any substance).

In the pre-use condition the at least one flap is in contact with the body, yet it is prevented from permanently fastening to it.

This pre-use condition of the invention is what defines the claimed product, and what is relevant to this appeal, as all the appealed claims relate to product or article claims (as opposed to method claims)

In any event, the subsequent use of the invention requires a pre-determined folding pattern of the body, so it can be placed in contact to the at least one flap, so the at least one area having a layer of a fastener substance avoids the one layer of a fastener inhibitor substance, and faces the at least one blank area free of any substance, whereby the letter sheet or form is self sealed. Again, these steps relate to the use of the product, as opposed to the claimed product itself. See Exhibit A (Model of Invention)

(6) Issues

1. The invention has been alternatively described and claimed as: a) a self sealing form, b) a self contained form and c) a self sealing letter sheet.

As indicated on (5) above, the claimed self sealing letter sheet or self sealing form is a letter sheet that upon actions taken by the user (steps of use) can seal and contain itself without the participation of an envelope.

As such, the notion proposed by the Office, that an already constructed envelope, constitutes prior art to the present invention is simply incorrect, inappropriate and unfair.

Accordingly, citing Schieman's or Wilbur's envelopes as prior art to the present invention is incorrect, inappropriate and unfair.

2. The claimed invention is made of a blank of a sheet material —e.g. paper—, which is folded to provide at least one mono-sectional body and at least one mono sectional flap, and the sheet material carries at least one layer of a fastener substance and at least one layer of a fastener inhibitor substance.

The at least one body is mono-sectional, because in its pre-use condition, (i.e. the claimed structure) is never folded so as to provide different panels or sections.

The at least one flap is mono-sectional because in its pre-use condition, (i.e. the claimed structure) is never folded so as to provide different panels or sections.

3. In this application, the meaning of the term 'Pressure Sensitive Adhesive', is the meaning established in the industry, i.e.:

An adhesive that is activated upon contact and slight pressure and which can be of two different kinds:

a) a low tack repositionable adhesive, like the adhesive in Post It™ products, which has been identified in the specification with the reference numeral 204 and/or

b) a permanent adhesive which for that reason needs to be protected by a release coating, prior to its use, and which has been identified with the reference numeral 202 in the specification.

An adhesive inhibitor normally refers to a release coating, and is identified with the reference numeral 206 in this application.

Accordingly, the only purpose of using an adhesive inhibitor (release coating) is to prevent the untimely and or accidental fastening of pressure sensitive

permanent adhesive coatings (202) to other surfaces.

Therefore, the use of an adhesive inhibitor (release coating) is only necessary when a pressure sensitive adhesive is used. It would be absurd, for instance to use a release coating in conjunction with a dry adhesive that is activated by its moistening. Such adhesive does not require any inhibition.

For that reason, a pressure sensitive adhesive of the permanent type (202) is used to seal (close) an item, as opposed to construct a container which will remain unsealed for an indefinite period of time.

The pressure in articles using pressure sensitive adhesive is manually exerted, hence this system is not used when sealing massive quantities of articles.

4. An envelope is a pre-assembled container.

As such, an envelope requires at least one (normally two) coatings of glue to fasten together its different walls so as to produce the container section.

The glue used to fasten the walls of a pre-assembled envelope is NOT a pressure sensitive adhesive (PSA), because it is of necessity an instantly activated glue. (e.g. heat activated glue), and there is therefore no need to protect this glue with a release substance.

The self sealing letter sheet of the present invention does not require this type of glue. It only requires one type of adhesive to seal the form, i.e. "Pressure sensitive adhesive, aka PSA, because the self sealing letter sheet of the present invention is not a pre-assembled container.

5. An applicant can act as his own lexicographer, and the meanings of the terms used in the specification are to be ascertained from the specification itself.

> «***Office personnel must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims. Markman v. Westview Instruments, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (In banc), aff'd, **U.S.**, 116 S. Ct. 1384 (1996)***»
>
> *Also see MPEP 2106: ...«"**Disclosure may be express, implicit or inherent. Thus, at the outset, Office personnel must attempt to correlate claimed means to elements set forth in the written description. The written description includes the specification and the drawings.***»

In academic terms, and especially in the context of this application's specification, an envelope by itself is not a piece of correspondence, as claimed by the Office (See page 16 of Amendment A, 5th and 6th paragraph) because it carries no message, which is the defining aspect of the term correspondence.

And even if by any semantic flexibility, an envelope is considered a piece of correspondence, it is then a piece of correspondence that is not analogous to a Self Sealing Letter Sheet, for that same reason (the fact that no private message is carried)

This is a very important issue, because the only justification provided by the Office for citing envelopes is the notion that an envelope is 'a piece of correspondence' (See Amendment A, page 16, para. 5 and 6; and Amendment B, page 24, para. 5 and 6), while the fact remains that even if an envelope is considered 'a piece of correspondence', —which is not— it has a completely different structural configuration than the present invention.

6. None of the appealed claims recite any panels, and in any event there is no parity or equivalence between the panels of a pre-assembled envelope, of the alleged prior art, which constitutes a structural defining element of an envelope before its use, and the panels resulting from folding the Self Sealing Letter sheet of the present invention by the user, which do not provide any

structural definition to the product before its use.

Score or folding lines are an optional and dispensable element of the invention, and their absence further defines the absence of panels in a body before its use. See specification, page 12, last sentence of fourth paragraph, See claims 1-22.

7. All the appealed claims are product or article claims, as such, and as established by the Office itself, use steps have no structural impact on them. Thus, it is improper to invoke these use steps for 102 or 103 rejections. See Amendment A, page 31, 3rd through last paragraph, and page 32, para. 1 through 3.

8. A notable obstruction in the prosecution of this case has been the erroneous interpretation of certain terms, which is in fundamental conflict with the meaning in the specification, and which has unduly served as basis for some rejections. These terms include:

Form/Self Sealing Form: In the context of this application, and fully supported by the specification, drawings, arguments, and all attachments, a form is a letter sheet. Hence, a self sealing form is a self sealing letter sheet. (**Not** an envelope as alleged by the Office)

See Exhibit A (model of Invention); see abstract, first sentence, **In the specification**, see: page 1, 2nd paragraph, See Figs. 7A-7B, 8, 9A-9B, 10A-10B, 12A-12B, 13, 14A, 15A-15B, 17A, 18, 19A, 20A-, 21, 22A, 23A, 24A, 25A-25B, and their respective descriptive text, which show and discuss the invention before its use, i.e. the claimed product or article, which for that reason excludes steps of use. See page 4 (Summary of Invention) first paragraph.

See ATTACHMENTS 11A, 11B, 12, 13, 14A and 14B. See Attachment 4.

NOTE: A petition to enter amendment C and its corresponding attachments was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please refer to:

- Attachments 15, 16, 18, 19 and 30.
- Page 25 of Amendment C.

Envelope: In the context of this application, and fully supported by the specification, drawings, arguments, and all attachments, an envelope is an already built and assembled container when it is offered to the public. All the user has to do is to 'stuff' it and seal it. User does not have to assemble it.

See ATTACHMENTS 11A, 11B and 12. See also Attachment 4. See US patents 2,367,440 to Schieman and 2,384,223 to Wilbur.

NOTE: A petition to enter amendment C and its corresponding attachments was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please refer to:

- Affidavit 4
- Attachments 21, 22, 23, 24, 25, 26, 27, 28 and 29

Correspondence: In the context of this application, and fully supported by the specification, drawings, arguments, and attachments, "correspondence" is a message. Therefore, an envelope is not a piece of correspondence.

See Amendment A, page 16, last para., Pages 17-18 and page 19, except

last paragraph. See page 20, last para. And page 21, para. 1-4. See Affidavit 3.

Body: In the context of this application, and fully supported by the specification, drawings, arguments, attachments, amendments and affidavits, the body of the self sealing letter sheet is the one-ply, unfolded **letter sheet itself, excluding the flap(s).** Just like the ***"body" of a vehicle is not analogous to the body of a letter sheet, the "body" of a container is not analogous to the body of a letter sheet.***

See Exhibit A, See page 39 of Amendment C, which was entered on the record after presented as a demonstration exhibit during interview of October 29, 2002.

Panels: In the context of this application, and fully supported by the specification, drawings, arguments and attachments, the panels of the body of a letter sheet IF and WHEN they exist DURING THE PRE-USE phase —as the result of the production of a score line— are merely side by side sections, and are never in a facing condition and much less glued together to conform a container. ***Just like the 'panels' of a roof are not analogous to the 'panels' of a letter sheet, the 'panels' of a container are not analogous to the panels of a letter sheet.*** See MPEP 2111.01.

See Exhibit A.

NOTE: A petition to enter amendment C and its corresponding attachments was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please refer to:

- Amendment C, pages 68-71 and page 72, para. 1 and 2.

(7) Grouping of Claims

	GROUPED CLAIMS	GROUND OF REJECTION	LOCATION IN SEPT. 11/02 O.A.
i)	45-49	35 U.S.C. 112. first paragraph for alleged lack of disclosure of a 'mono-sectional' body	Page 2, Section 4. Page 3, Section 5.
ii)	49	35 U.S.C. 112. first paragraph because 'mono-sectional' is allegedly new matter	Page 3, Section 5, second sentence.
iii)	68-70	35 U.S.C. 112. first paragraph for alleged lack of disclosure of a letter sheet having a repositionable adhesive, and a dry adhesive	Page 3, Section 7
iv)	45-49	35 U.S.C. 112. second paragraph for alleged inaccuracy and indefiniteness for using the term 'manufactured'	Page 4, Section 9 Page 4, Section 10
v)	50-53	35 U.S.C. 112. second paragraph for alleged indefiniteness, because allegedly, the letter sheet is not manufactured by placing a flap in contact with the body.	Page 4, Section 11 Page 4, Section 12
vi)	45-47, 62-64 and 66	35 U.S.C. 102(b) as allegedly anticipated by Schieman	Page 5, Section 15
vii)	45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67	35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman	Pages 5/6, Section 17
viii)	48, 52, 56, and 65	35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman and Stenner	Page 6, Section 18
ix)	59 and 61	35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman	Pages 6/7, Section 19

(8) Argument

Rejections under 35 USC 112, first paragraph

i) Rejection of claim 45 and its dependent claims 46-49

(See O.A. Of Sept. 11/02, page 2, section #4)

Office rejected claim 45 and all its dependent claims under 112, first paragraph as containing subject matter which was not described in the specification to convey the claimed invention to one skilled in the art, alleging that:

«there is no original disclosure of a "mono-sectional body", and that "all of the disclosed envelope* bodies have more than one section."»

This rejection is erroneous, as claim 45 and its dependent claims 46-49 fully comply with 35 USC 112.

See claims 1-22, which do not recite any 'sections' to the body.

Further, see Page 12, 4th para., last sentence of original specification, which clearly states:

> **"Score or folding lines may also be substituted by printed guides or may simply be omitted"** (Emphasis added here)

It is a simple matter of logic that if there are no score lines or otherwise separating lines, and if the body is unfolded —**as it always is**— in the pre-use condition, the body is mono-sectional.

> **(* CORRECTION NOTE: The disclosed and the claimed invention is a 'self sealing form' or a 'self sealing letter sheet', NOT an envelope as characterized by the Office Action in this rejection)**

Office Additionally alleges (See last 4 lines of page 2) that:

«"each envelope** in the original disclosure has only one "body"»

This assertion is erroneous, as claim 45 and its dependent claims 46-49 fully comply with 35 USC 112, first paragraph.

Refer to 13th embodiment (Figs. 24A-24N), which is defined as a "two-way self sealing mailer" and which has a first mailer (first body) 238 and a second mailer (second body) 244. Also, refer to 14th embodiment (Figs 25A- 250), which is also a "two way self sealing mailer" and which has a message panel (message body) 264, reply mailer 244 (reply body) and addressing panel 266 (addressing body)

Furthermore, see claims 4 and 20. See MPEP 2163, para. 1. See MPEP 2163.06.

(* <u>CORRECTION NOTE:</u> The disclosed and the claimed invention is a 'self sealing form' or a 'self sealing letter sheet', NOT an envelope as characterized by the Office Action in this rejection)

ii) **<u>Additional rejection of claim 49</u>**

(See O.A. Of Sept. 11/02, page 3, section #5)

Office further rejected claim 49 under 35 USC 112, first paragraph as containing subject matter which was not described in the specification to convey the claimed invention to one skilled in the art, alleging that the phrase "at least one mono-sectional" flap is new matter.

This rejection is erroneous, as claim 49 fully complies with 35 USC 112, first paragraph.

See Fig. 24A (13th embodiment). The second mailer (second body) 244 has at least one mono-sectional flap (flaps 246, 248, and 250). None of these flaps is divided. So they have only one section, and that is the defining

characteristic of the term "mono-sectional'. Also, see Fig. 25A of 14th embodiment. The reply mailer 244 (reply body) has at least one mono-sectional flap (flaps 246 and 248) .

See claims 1-22, which do not recite any sections to the flaps. See MPEP 2163.06.

iii) **Rejection of claims 68-20**

(See O.A. Of Sept. 11/02, page 3, section #7)

Office rejected claims 68-70 under 112, first paragraph as containing subject matter which was not described in the specification to convey the claimed invention to one skilled in the art, alleging that "there is no original disclosure of a letter sheet having one layer of repositionable adhesive"

This rejection is erroneous, as claims 68-70 fully comply with 35 USC 112, first paragraph.

Refer to Summary of Interview submitted by applicant on November 22, 2002. See page 3, section 5).

Refer to 8th paragraph of page 13, which specifically discloses:

"Another alternate three panel self contained form (not shown) of this 1st embodiment is obtained by omitting the adhesive inhibitor 206 and using a dry adhesive substance as the adhesive layers 202, that is activated by its moistening. **For the temporary connection of the flaps to the body, a low tack adhesive 204 is used, interacting with a facing space that has no layer of any substance**."

Similar disclosures appear on page 14, 10th para.; page 215, 8th para.; page 16, last para. continued on page 17; page 17, last para. continued on page 18; page 18, 8th para.; page 19, 3rd para., page 19, 9th para.

Also, refer to FIG. 1; FIGS. 5A **and** 5B; **and** FIGS. 6A **and** 6B, **and their respective text on the specification. See also Page 10, 1st and 2nd paragraphs.**

Also, refer to page 5, last paragraph.

All these entries relate to the repositionable adhesive layer (204) , and teach how to utilize it, as it is recited by claims 68-70.

Rejections under 35 USC 112, second paragraph

iv) **Rejection of claim 45 and its dependent claims 46-49**

(See O.A. Of Sept. 11/02, page 4, sections #9 and 10)

Office rejected claim 45 under 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention, alleging that:

«the limitations preceding the phrase "whereby said self sealing letter is manufactured" are not manufacturing steps.»

This rejection is erroneous as claim 45 and all its dependent claims fully comply with 35 USC 112, 2nd paragraph.

All the limitations preceding such phrase are the conditions and requirements for the form to be produced, and then made available to the public for its use. The verb (to) manufacture is a synonymous of the verb (to) produce.

Also, see MPEP 2173.05(p)

> *...A claim to a device, apparatus, manufacture or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process...*

v) **Rejection of claim 50 and its dependent claims 51-53**

(See O.A. Of Sept. 11/02, page 4, section #11 and 12)

Office rejected claim 50 and its dependent claims 51-53 under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention, alleging that:

«the letter sheet is not manufactured by placing a flap in contact with a body»

Just like a "letter sheet" is simply produced by cutting a blank of paper (or similar material) to the desired size, and offered for sale to the public, a "Self Sealing Letter Sheet" is a "letter sheet" further having (at least) one flap, (at least) one release layer and (at least) one adhesive layer, to enable the "self sealing" properties.

Thus, yes, the letter sheet is precisely produced by placing the flap in contact with the body, so the at least one adhesive layer is protected and the letter sheet is ready to be used.

Please, see model (EXHIBIT A), submitted on October 17, 2002 under 37 CFR 1.91 (a) (3)

Also, see Summary of Interview of October 29, 2002 submitted by applicant on November 22, 2002 (see page 3, section 4) of Summary of Interview)

And, also see page 39 of Amendment C, which was used as a demonstration exhibit during that interview, and is therefore on the record now.

See MPEP 2164.01

Rejections under 35 USC 102(b), second paragraph

vi) **Rejection of claims 45-47, 62-64 and 66**

(See O.A. Of Sept. 11/02, page 5, section #15)

Office rejected claims 45-47, 62-64, and 66 under 102(b) as being anticipated

by Schieman

Claims 45-47 claim a self sealing letter sheet. See (6) Summary of Invention above.

Claims 62-64 and 66 claim a self sealing form. See (6) Summary of Invention above.

For all the reasons on record, starting with the fact that Schieman is a structurally (and functionally) different product, it is inconceivable that an envelope (a pre-assembled, glued together container) could anticipate a self sealing letter sheet or a self sealing form.

NOTE: A petition to enter amendment C and its corresponding attachments was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please, refer to:

- Attachments 15, 16, 18, 19, 20, 21, 22, 23, 24, 25, 26, and 27.
- page 41 of Amendment C.
- Models of references, submitted as EXHIBITS B, C, D and E, under 37 CFR 1.91(a)(1)
- Affidavit 4.

Likewise, a petition to enter Substitute specification which was denied entry by Advisory Action of 10/25/02 was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please, refer to:

- Page 15 of substitute specification, last paragraph, page 16 of substitute specification, paragraphs 1 and 2.

Schieman's "body" is a container, having two facing panels, and one of the two facing panels is made of three overlapping sections secured together by the use of two layers of a heat activated adhesive. Further, Schieman requires that in the pre-use condition, the two flaps are in contact to one another, while this invention requires that the flap is in contact and temporarily fastened to the body, which is a one single ply of a sheet material, and which therefore has no container portion.

Also, refer to Model (Exhibit A) submitted under 37 CFR 1.91 (a)(3), on October 17, 2002. See ATTACHMENTS 4, 11A, 11B, 12, 13, 14A and 14B.

See Amendment A, page 19, last para., page 20 except last para. See page 20 last paragraph and page 21, para. 1-4, which discusses evidence that the PTO had already recognized that there is no parity or analogy between an envelope and a Self Sealing Form or Self Sealing Letter Sheet, during the examination of earlier application # 09/032,853, as out of the eight references cited, none is a pre-assembled envelope. See Attachment 2.

Office further states that Schieman discloses a mono-sectional body. This is an incorrect statement.

The body of Schieman is 'tetra-sectional', as it has four (4) sections, namely: a first wall made of one section, and a second wall made of three overlapping sections. Schieman's body further requires two layers of non-pressure sensitive adhesive (heat activated), to fasten together the three sections of the second wall, to define the body, i.e. a pre-assembled container. Schieman's body is therefore, anything but 'mono-sectional'

See MPEP 2131: "To anticipate a claim, the reference must teach every element of the claim"

See **ATTACHMENTS 11A, 11B and 12. See Exhibit A.** See Amendment A,

page 29, last 3 paragraphs, page 30, para. 1-5.

Furthermore, and now referring to Schieman's flaps, they have no equivalence with the present invention's flaps, regardless of the semantic interpretation chosen, because:

In the present invention each and every flap is always connected to the body, is never divided in sections, and it is never required to interact with another flap, in clear distinction with Schieman's two embodiments:

a) In Figure 1, (first Embodiment) Schieman shows a bi-sectional flap, where both sections must interact mutually in a pre-use condition; or if each section is interpreted as an individual flap, then the flap with the adhesive strip 3 is connected to the flap having the repellent zone, and must interact with it.

Neither of these two interpretations is ever embodied by the present invention, and even less recited by claims 45-47, 62-64, or 66.

b) In Figures 5, 6 and 7 (second embodiment) Schieman shows an individual flap having an adhesive strip 3 and a flap having a repellent zone 6, which must interact together during the pre-use stage.

This situation is never embodied by the present invention, and even less recited by claims 45-47, 62-64, or 66.

Claim 45 and hence, its dependent claims (see clause d) specifically require that to produce the self sealing letter sheet, the (at least) one, two, three or 'N' flaps be in contact with the body. i.e. **each flap** needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired, which constitutes a fundamental distinction over the cited reference, even if it was a valid reference, which is not.

Claim 62 and hence, its dependent claims (see clause b) specifically require

that the at least one flap overlaps the body, i.e. **each flap** needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired, which constitutes a fundamental distinction over the cited reference, even if it was a valid reference, which is not.

See MPEP 2131: "To anticipate a claim, the reference must teach every element of the claim"

And sealing is a function of use, which therefore is not relevant to the structural recitation of the claim, as pointed out by the Office on page 10 of action dated June 20/02. But in any event, sealing is achieved by folding the body, and placing it into contact with the flap, while avoiding the release layer.

Whereas

Depending on the embodiment and the semantic interpretation chosen, Schieman requires that both sections of the flap —or both flaps— be in contact with one another, prior to sealing the envelope. And in any event, sealing the envelope, which is not a structural element, but rather a step of use, does NOT require folding the body of the envelope.

Furthermore, Office Action of September 11, 2002 (page 5, last three lines of section 15) states that "all of the claimed function can be performed with Schieman's structure".

This contention is:

a) moot, because claims 45-47, 62-64 and 66 are product claims, claiming the structure, and not the function,

and if hypothetically considered to be pertinent, this contention is:

b) incorrect, because the claimed invention, is as structurally different from Schieman's disclosure as a letter size piece of paper is from an assembled #10

(or any size) envelope.

Office Action incorrectly states that the term "Letter Sheet" does not define over Schieman. Again, the term "Letter Sheet" is as defining over Schieman's, as the term "Letter Sheet" is defining over any envelope. In structural terms, they are simply two completely different types of products.

See MPEP 2111.02:

> *"Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."*

See MPEP 2131:

> *"To anticipate a claim, the reference must teach every element of the claim"*

And looking at it from another angle:

Even if hypothetically speaking, and by virtue of some imaginary nomenclature stretching, the self sealing form of the present invention is called an "envelope", it is completely different to "Schieman's" or anybody's envelope, as it would be an **unassembled** envelope ***(Which is in itself a contradiction, as what constitutes and defines an envelope is its assembly as such)*** that would have to be assembled by the user. And it has been established that use steps do not provide limitations in an article claim. Further, the construction is completely different, and furthermore, no **heat activated glue** is involved in the process of producing the forms, as no walls, panels or any elements are pre-adhered in a permanent, sealing manner.

Rejections under 35 USC 103(a)

vii) **Rejection of claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67**

(See O.A. Of Sept. 11/02, pages 5/6, section #17)

Office rejected claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67 under 103(a) as unpatentable over Johnson, in view of Wilbur or Schieman.

This rejection is erroneous because two of the references are not valid, and hence can not be a part of a 103(a) rejection, and further:

For all the reasons on record, starting with the fact that Schieman and Wilbur are structurally (and functionally) different products with respect to this invention, it is inconceivable that an envelope (a container) would be combined with a 'Reply Letter Sheet', because they simply belong to two different species.

The only outcome of such combination, if a useful product is obtained, would be of necessity a new species. And if that in fact occurs, such combination is by its own nature and by statute novel and patentable. See attachments 4, 11A, 11B, 12, 13, 14A, and 14B. See Exhibit A. See Amendment A, page 29, last 3 paragraphs, page 30, para. 1-5.

NOTE: A petition to enter amendment C and its corresponding attachments was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please refer to:

- Exhibits B, C, D and E.
- Attachments 15, 16, 21, 22, 23, 24, 25, 26, 27 and 28.
- Affidavit 4
- Pages 41, 44, 47 and 50 of Amendment C.

Schieman's "body" is a container, having two facing panels, and one of the two facing panels is made of three overlapping sections secured together by the use of two layers of a heat activated adhesive. Further, Schieman requires that in the pre-use condition, the two flaps are in contact to one another, while this invention requires that the flap is in contact and temporarily fastened to the body, which is a one single ply of a sheet material, and which therefore has no container portion. Wilbur's first embodiment is a replica of Schieman's second envelope embodiment. There is simply no motivation to combine an envelope (Wilbur or Schieman) with a Reply Letter Sheet (Johnson).

And Wilbur's second embodiment is even much more different than the present invention, as it further requires an additional layer of release on the outer side of the tab 20, and a layer of adhesive on upper flap 16, which is to interact with the other layer of adhesive 30.

Thus, these differences also disqualify Wilbur as a valid reference.

And since they both belong to another species, there is no reason whatsoever to combine them with Johnson.

And, Johnson's disclosure itself teaches away from such combination. Johnson states on 3rd paragraph of col.1: "The primary object of this invention is to provide a reply letter of simplified construction, as compared to that of my pending application, while retaining the advantages accruing from a tear string arrangement operable by the original recipient and by the return addressee."

And such tear strings 15 and 17 are to be mounted by glue, or other adhesive means to the material of the sheet letter. (See Johnson's col. 2, lines 61-65)

For obvious practical reasons, the system of the present invention, requires that the release layer is applied first, then the pressure sensitive adhesive. (If

the adhesive —Pressure Sensitive Adhesive— is applied first, the coating of release will be prevented, as the exposed **and active** adhesive will adhere to rollers and/or other parts of the equipment used, and the adhesive will be ruined or at least contaminated.

To commercially produce the letter sheets, the incorporation of Johnson's intrinsic tear string poses a serious problem, because if the strings are applied before the pressure sensitive adhesive, they will disturb the coating of the latter. If the pressure sensitive is applied first, and before their folding, the pressure sensitive will be exposed, and therefore will obstruct the mounting of the strings. If the flaps are folded, then the mounting of the strings would have to be performed manually, dramatically increasing production costs, and rendering the project impractical.

Since the adhesive necessary to mount the strings is of the same kind of the dry adhesive necessary to seal the letter, a system whereby both, the coating of the sealing adhesive and the mounting of the strings can be sequentially achieved, should be implemented to maximize efficiency and reduce costs. This clearly teaches away from using a pressure sensitive adhesive, anywhere in the piece.

Furthermore, as a key feature of the present invention is to be suitable for laser printers and other friction and heat generating machines (see specification, page 4, first ywo lines), the incorporation of interactive release and pressure sensitive adhesive is not compatible with Johnson's invention, because the tear string will be exposed at all times, and worse yet, the mounting adhesive of the tear string will also be exposed and hence activated by the heat, or at least disturbed and/or be disturbed by the rollers or parts of the machine, which will inevitably jam the piece inside the printer or machine. Johnson teaches away from using pressure sensitive adhesive. Without Pressure Sensitive adhesive there's no need to use a release layer. Accordingly, there is

no motivation to the suggested combination, and as established before, there's no reasonable expectation of success to produce such combination, and even less expectation of success for its use. Please, see MPEP 2143.

Also, see **Affidavit 1, section II**; which demonstrates a 'long felt need in the art', and 'failure of others' by way of showing references structurally closer to this invention than those cited by the Office, which disprove any instance of 'obviousness' See **MPEP 716.02** . See also ATTACHMENT 9 submitted with Amendment A. See Amendment A, page 29, last 3 paragraphs, page 30, para. 1-5.

Now referring to Sept. 11/ 02 Office Action's assertion starting on page 6, 2nd line, as follows: "...flaps 8, 8, and 9 which contain adhesive and folded onto panel 4, but not sealed thereto. It would have been obvious to provide panel 4 of Johnson with adhesive inhibitor adjacent to flaps 8, 8, and 9 as taught by either Wilbur at 24 or Schieman at 4, because the inhibitor would have prevented unintentional sealing of flaps 8, 8 and 9 to the form..."

That would simply be a waste of the adhesive inhibitor. As stated on the first sentence of the very quote above ""...flaps 8, 8, and 9 which contain adhesive and folded onto panel 4, but not sealed thereto. "" So there is no need whatsoever to use an adhesive inhibitor to interact with a layer of dry adhesive, as the adhesive is not active, i.e., does not need any inhibition. In any event, for all the reasons presented, these claims depend on allowable claims, and since they offer yet more limitations, they are a fortiori patentable.

CORRECTION NOTE: As for the comment regarding claim 47, which as a dependent claim receives all the limitations of independent claim 45, and is therefore patentable, applicant offers correction to the allusion that pressure sensitive is "old and well known for use with envelope flaps", because the present invention is not an envelope.

viii) Rejection of Claims 48, 52, 56, and 65

(See O.A. Of Sept. 11/02, page 6, section #18)

Office rejected claims 48, 52, 56, 60 and 65 under 103(a) as unpatentable over Johnson, in view of Wilbur or Schieman, and further in view of Stenner.

This rejection is erroneous, because three of the references are not valid, and hence they can not be a part of a 103 rejection, and further:

For all the reasons on the record, starting with the fact that Schieman and Wilbur are structurally (and functionally) different products with respect to this invention,

And Stenner is a multiple envelope with enclosures, which disqualifies it as a reference against a self sealing letter sheet.

Thus, it is inconceivable that an envelope, and a reply sheet be combined with a piece of 'direct mail' with plurality of envelopes and enclosures because they all relate to different species.

The only outcome of such combination, if it results in a useful product, would be of necessity a new species. And if that in fact occurs, such combination is by its own nature and by statute novel and patentable.

Schieman's "body" is a container, having two facing panels, and one of the two facing panels is made of three overlapping sections secured together by the use of two layers of a heat activated adhesive. Further, Schieman requires that in the pre-use condition, the two flaps are in contact to one another, while this invention requires that the flap is in contact and temporarily fastened to the body, which is a one single ply of a sheet material, and which therefore has no container portion. See ATTACHMENTS 4, 11A, 11B, 12, 13, 14A and 14B. See Exhibit A. See Amendment A, page 29, last 3 paragraphs, page 30, para. 1-5.

NOTE: A petition to enter amendment C and its corresponding attachments was submitted to the Commissioner, and a response is pending. Upon its eventual entry, or at the discretion of the Board, please refer to:

- Exhibits B, C, D and E.
- Attachments 15, 16, 21, 22, 23, 24, 25, 26, 27 and 28.
- Affidavit 4
- Pages 41, 44, 47 and 50 of Amendment C.

Wilbur's' first embodiment is identical to Schieman's second embodiment, and hence is also invalid. Wilbur's second embodiment has even more differentiating features, as it requires a layer of release on the outer side of the smaller (bottom) flap, and a layer of adhesive on the inner side of the (larger) top flap.

Since Johnson is a product different than Schieman or Wilbur, there could not be a reason or motivation to combine them, and even if they could hypothetically be combined, Johnson's tear string makes undesirable such combination, as coating of the pressure sensitive adhesive would be obstructed by the tear string if applied first, and vice versa. Also, the permanently exposed adhesive of the tear string will prevent the feeding of the form trough heat and friction generating printers and machines, which is an important aspect of the present invention (see page 4 of specification, first two lines). Therefore, there is no motivation to combine Johnson with Wilbur or Schieman, if such combination was hypothetically possible, and there is not reasonable expectation of success in producing such device in a cost effective way, and even less expectation of success to use it with friction or heat generating printers.

Thus, rejection of claims 48, 52, 56, 60 and 65 further combining such invalid combination with Stenner can only result in another invalid rejection.

Claims 48, 52, 56, 60 and 65, relate to a series of detachable letter sheets. A letter sheet is produced, and then offered to the public having its **body** in an **unfolded** condition. The only 'folding' of the **letter sheet** relates to having the flap(s) bent towards the body. The purpose of doing this is to a) protect the adhesive on the flap by contact with the release on the body and b) keeping flap and body removably fastened to one another so the letter sheet is in a flatter, steadier condition for handling, packaging, displaying, and very importantly: printing.

But continuous-detachable self sealing letter sheets per se are **not** a finished mailing piece. The letter sheet is manufactured according to description of FIGS. 15A-15B; 16; 18; 20A-20E and 21 and their corresponding text on the specification, and it is offered to the user in that condition. Then, the user must print or write the information, and then detach, fold and seal the piece, to produce the finished mailing item.

For this reason, the interaction of the pressure sensitive adhesive and the release is convenient and advantageous to the user. Because s/he will be able to seal the letter sheet without having to use an envelope, a staple, a piece of tape or any other foreign element.

But Stenner discloses "direct mail articles and commercial methods for preparing large numbers of such articles, each of which comprises a plurality of envelopes containing one or more enclosures" (col.1, 2nd para.)

This is very eloquent about the structural distinction of the reference with respect to this invention, and the lack of purpose to incorporate release and pressure sensitive adhesive into Stenner.

First, this establishes a categoric difference with respect to this invention in

that each of Stenner's article comprises a plurality of envelopes, which further contain one or more enclosures, while each detachable article of the claims in question is one single detachable letter sheet, all the letter sheets are identical, and no enclosures are recited. No enclosures are even possible as the letter sheet does not have any container in the pre-use condition.

And the fact that the purpose of Stenner is to prepare extremely large numbers of such articles, (see col. 2, line 51 on) coupled with the fact that the sealing of envelopes 13 occurs sequentially and intantly, indicates that there is no purpose or need to have release layers. There is no "temporary sealing" phase necessary in Stenner's disclosure.

And further, pressure sensitive adhesive products, by their own nature are intended to be used in small or even individual scales, as the "pressure" is manually provided by the user when sealing the pieces. See MPEP 2143.01: "The proposed modification cannot change the principle of operation of a reference"

Furthermore: If the adhesive is changed from dry adhesive to Pressure Sensitive Adhesive, the flaps must be folded against the body so their adhesive is protected by the release on the body. But given the necessarily extended (unfolded) configuration of all 'Composite sheets' or 'webs' 10 in all embodiments, this is physically **impossible** without first separating the enclosure device sheets 11 and the integral envelope sheets 13, which will instantly defeat the purpose of Stenner.

It is clear that not only this is an inadequate reference but there is not any reason or advantage in combining it with the other references, which are also inadequate references.

Also, see Affidavit 1, **section II**, which demonstrates a 'long felt need in the art', and 'failure of others' by way of showing references structurally closer to this invention than those cited by the Office, which disprove any instance of

'obviousness' See MPEP 716.02(e) . Also. see **ATTACHMENT 9**, which is a photograph and respective caption of product # 8325 by Avery Dennison ("Self Seal Mailer"), as evidence of structurally closer references that have failed to produce the results provided by the present invention.

ix) Rejection of claims 59 and 61

(See O.A. Of Sept. 11/02, pages 6/7 section #19)

Office rejected claims 59 and 61, as unpatentable over Johnson in view of either Wilbur or Schieman, as applied to claim 54.

This is an invalid rejection as Schieman or Wilbur are invalid references, and further because Johnson teaches away from the combination proposed by the Office, which is ultimately an invalid combination.

Thus, it is inconceivable that an envelope, and a reply letter sheet be combined, because they relate to two different species.

The only outcome of such combination, if it results in a useful product, would be of necessity a new species. And if that in fact occurs, such combination is by its own nature and by statute novel and patentable.

Schieman's "body" is a container, having two facing panels, and one of the two facing panels is made of three overlapping sections secured together by the use of two layers of a heat activated adhesive. Further, Schieman requires that in the pre-use condition, the two flaps are in contact to one another, while this invention requires that the flap is in contact and temporarily fastened to the body, which is a one single ply of a sheet material, and which therefore has no container portion. See ATTACHMENTS 4, 11A, 11B, 12, 13, 14A and 14B. See Exhibit A. See Amendment A, page 29, last 3 paragraphs, page 30, para. 1-5.

Wilbur's' first embodiment is identical to Schieman's second embodiment, and hence is also invalid. Wilbur's second embodiment has even more differentiating features, as it requires a layer of release on the outer side of the

smaller (bottom) flap, and a layer of adhesive on the inner side of the (larger) top flap, and is therefore, a fortiori, invalid.

Since Johnson is a product different than Schieman or Wilbur, there could not be a reason or motivation to combine them, and even if they could hypothetically be combined, Johnson's tear string makes undesirable such combination, as coating of the pressure sensitive adhesive would be obstructed by the tear string if applied first, and vice versa. Also, the permanently exposed adhesive of the tear string will prevent the feeding of the form trough heat and friction generating printers and machines. Therefore, there is no motivation to combine Johnson with Wilbur or Schieman, if such combination was hypothetically possible, and there is not reasonable expectation of success in producing such device in a cost effective way, and even less expectation of success to use it with friction or heat generating printers.

Also, see Affidavit 1, **section II**, which demonstrates a 'long felt need in the art', and 'failure of others' by way of showing references structurally closer to this invention than those cited by the Office, which disprove any instance of 'obviousness' See MPEP 716.02(e) . Also. see **ATTACHMENT 9**, which is a photograph and respective caption of product # 8325 by Avery Dennison ("Self Seal Mailer"), as evidence of structurally closer references that have failed to produce the results provided by the present invention.

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- Affidavit 4
- Pages 41, 44, 47 and 50 of Amendment C.

(9) **Appendix** *(Claims being appealed)*

45) A self sealing letter sheet, so structured as to enable:

1) a private message and

2) a discretionary non-private message,

so the need for an envelope is eliminated,

said self sealing letter sheet comprising:

a) a blank of a sheet material, further comprising:

b) at least one mono-sectional flap,

c) at least one mono-sectional body,

d) at least one layer of adhesive, and at least one layer of adhesive inhibitor applied to said blank of a sheet material, in such a manner that when said at least one mono-sectional flap is in contact with said at least one mono-sectional body, said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, whereby said at least one mono-sectional flap and said at least one mono-sectional body can be removably fastened to one another,

whereby said self sealing letter sheet is manufactured,

and whereby the user can input said private message and said discretionary non-private message, and subsequently fold and seal said self sealing letter sheet.

46) The self sealing letter sheet of claim **45)**, wherein said body further comprises at least one score line to aid the user to fold said body.

47) The self sealing letter sheet of claim **45)**, wherein said sheet material is paper, said adhesive is pressure sensitive adhesive, and said adhesive inhibitor is a release substance.

48) The self sealing letter sheet of claim **45)**, wherein said self sealing letter sheet is one of a continuous assembly of detachable self sealing letter sheets.

49) The self sealing letter sheet of claim **45)** wherein said self sealing letter sheet further comprises means for detachment of a section of said self sealing letter sheet, and said section further comprises:

e) at least one mono-sectional flap,

f) at least one mono-sectional body,

g) at least one layer of adhesive, and at least one layer of adhesive inhibitor applied to said section, in such a manner that when said at least one mono-sectional flap is in contact with said at least one mono-sectional body, said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, whereby said at least one mono-sectional flap and said at least one mono-sectional body can be removably fastened to one another,

whereby a detachable subordinate self sealing letter sheet is produced.

50) A self sealing letter sheet, comprising:

a) at least one flap,

b) a rectangular body,

c) at least one layer of an adhesive substance applied to said at least one flap,

d) at least one layer of an adhesive inhibitor substance applied to said rectangular body,

so when said at least one flap is placed in contact with said at least one body,

said self sealing letter sheet is manufactured.

51) The self sealing letter sheet of claim **50)**, wherein said rectangular body further comprises at least one score line to aid the user to fold said rectangular body.

52) The self sealing letter sheet of claim **50)**, wherein said self sealing letter sheet is one of a continuous assembly of detachable self sealing letter sheets.

53) The self sealing letter sheet of claim **50)** wherein said self sealing letter sheet further comprises means for detachment of a section of said rectangular body, and said section further comprises:

e) at least one flap,

f) a rectangular subordinate body,

g) at least one layer of an adhesive substance applied to said at least one flap,

h) at least one layer of an adhesive inhibitor substance applied to said rectangular subordinate body,

so when said at least one flap is placed in contact with said rectangular subordinate body,

a detachable subordinate self sealing letter sheet is produced.

54) A self sealing letter sheet, folded so it comprises:

1) a first ply and

2) a second ply,

wherein said first ply is a body,

and said second ply is at least one flap, overlapping said first ply,

further comprising:

a) at least one layer of adhesive on said second ply, and

b) at least one layer of adhesive inhibitor on said first ply,

arranged so when said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, said second ply is temporarily fastened to said first ply, whereby said self sealing letter sheet is produced.

55) The self sealing letter sheet of claim **54)**, wherein said body further comprises at least one score line to aid the user to fold said body.

56) The self sealing letter sheet of claim **54)**, wherein said self sealing letter sheet is one of a continuous assembly of detachable self sealing letter sheets.

57) The self sealing letter sheet of claim **54)**, wherein said self sealing letter sheet further comprises means for detachment of a section of said self sealing letter sheet, and said section is folded so it further comprises:

1a) a first ply and

2a) a second ply,

wherein said first ply is a body,

and said second ply is at least one flap, overlapping said first ply,

further comprising:

c) at least one layer of adhesive on said second ply,

d) and at least one layer of adhesive inhibitor on said first ply,

arranged so when said at least one layer of adhesive on said second ply faces said at least one layer of adhesive inhibitor on said first ply; said second ply is temporarily fastened to said first ply, whereby a detachable subordinate self sealing letter sheet is produced.

58) The self sealing letter sheet of claim **57)**, wherein said body further comprises at least one score line to aid the user to fold said body.

59) The self sealing letter sheet of claim **54)**, wherein said self sealing letter sheet further comprises a third ply, wherein said third ply is at least one flap partially overlapping said second ply and partially overlapping said first ply.

61) The self sealing letter sheet of claim **59)**, wherein said body further comprises at least one score line to aid the user to fold said body.

62) A self sealing form, comprising:

a) a sheet material cut into such a shape that a body and at least one flap are obtained,

b) at least one coating of a fastener and at least one coating of a fastener inhibitor, applied to said sheet material, in such a manner that when said at least one flap overlaps said body, said at least one layer of a fastener faces said at least one layer of a fastener inhibitor,

whereby said at least one flap fastens to said body in a temporarily fashion, and

whereby said self sealing form is manufactured, and is ready to be used.

63) The self sealing formt of claim **62)**, wherein said sheet material is paper, said fastener is an adhesive substance and said fastener inhibitor is an adhesive inhibitor substance.

64) The self sealing form of claim 63), wherein said adhesive substance is a pressure sensitive adhesive substance, and said adhesive inhibitor substance is a release substance.

65) The self sealing form of claim **62)**, wherein said self sealing form is one of a continuous assembly of detachable forms.

66) The self sealing form of claim **62)**, wherein said body further comprises at least one score line to aid the user to fold said body.

67) The self sealing form of claim **62)** wherein said self sealing form further comprises means for detachment of a section of said self sealing form, and said section further comprises:

c) a body and at least one flap,

d) at least one coating of a fastener and at least one coating of a fastener inhibitor, applied to said section of said self sealing form, in such a manner that when said at least one flap overlaps said body, said at least one layer of a fastener faces said at least one layer of a fastener inhibitor,

whereby said at least one flap fastens to said body in a temporarily fashion,

whereby a detachable subordinate form is produced.

68) A self sealing letter sheet folded so it comprises:

a) a body and

b) at least one flap,

at least one layer of a repositionable adhesive and at least one layer of a dry adhesive, wherein said dry adhesive is susceptible to become active upon being moistened,

and wherein said at least one layer of a repositionable adhesive and said at least one layer of a dry adhesive are disposed so when said at least one flap and said body are in contact to one another, said repositionable adhesive and said dry adhesive avoid facing one another, and said at least one flap and said body are fastened to one another in a temporary fashion by the action of said repositionable adhesive,

whereby said self sealing letter sheet is produced and is now ready to be used.

69) The self sealing letter sheet of claim **68)**, wherein said self sealing letter sheet is one of a continuous assembly of detachable letter sheets.

70) The self sealing letter sheet of claim **68)**, wherein said body further comprises at least one score line to aid the user to fold said body.